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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/584,946

07/05/2006

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Q95800

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23373 7590 05/11/2011  
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EXAMINER

MURRAY, JEFFREY H

ART UNIT

PAPER NUMBER

1624

NOTIFICATION DATE

DELIVERY MODE

05/11/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/584,946	<b>Applicant(s)</b> NAKAZATO ET AL.
	<b>Examiner</b> JEFFREY MURRAY	<b>Art Unit</b> 1624

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 April 2011.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                                                                                                                                                                                                                                                                      |                                                                                                                                                                                                                                       |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br/>             Paper No(s)/Mail Date <u>7/6/2006; 11/27/2007; 1/4/2008; 5/7/2009; &amp; 7/26/2010</u></p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)<br/>             Paper No(s)/Mail Date. _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application</p> <p>6) <input type="checkbox"/> Other: _____</p> |
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### **DETAILED ACTION**

This action is in response to an election from a restriction requirement filed on April 29, 2011. There are nine claims pending and nine claims under consideration. Claims 8 and 9 have been withdrawn as claims directed to a non-elected invention. This is the first action on the merits. The present invention relates to a therapeutic agent for diseases in which corticotropin releasing factor (CRF) is considered to be involved, such as depression, anxiety, Alzheimer's disease, Parkinson's disease, Huntington's chorea, eating disorder, hypertension, gastral diseases, drug dependence, cerebral infarction, cerebral ischemia, cerebral edema, cephalic external wound, inflammation, immunity-related diseases, alpecia, irritable bowel syndrome, sleep disorders, epilepsy, dermatitides, schizophrenia, pain, etc. Election was made **without** traverse in the reply filed on April 29, 2011. Therefore this restriction is considered proper and thus made **FINAL**.

### ***Specification***

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any of the errors of which applicant may become aware of in the specification.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: In Claim 1, line 3, delete the open parentheses that appears before the phrase, "wherein E is N or CR<sup>10</sup>;" and the closing parentheses in the second to last line of the claim after the phrase, "r is 1 or 2". Appropriate correction is required.

***Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a pyrrolopyrimidine or pyrrolotriazine compound or pharmaceutically acceptable salt of Formula [I] wherein R<sup>2</sup> is alkyl; R<sup>3</sup> is hydrogen; and Ar is a substituted phenyl ring, does not reasonably provide enablement for all of the other R or Ar groups listed nor any individual isomers, racemic or non-racemic mixtures of isomers or hydrates within the broad Claim 1. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The test of enablement is whether one skilled in the art could make and use the claimed invention from the disclosures in the application coupled with information known in the art without undue experimentation. (United States v. Teletronics Inc., 8 USPQ2d 1217 (Fed. Cir. 1988)). Whether undue experimentation is needed is not based on a single factor, but rather a conclusion reached by weighing many factors (See Ex parte Forman 230 USPQ 546 (Bd. Pat. App. & Inter. 1986) and In re Wands, 8 USPQ2d 1400 (Fed. Cir. 1988)).

These factors include the following:

1) *Amount of guidance provided by Applicant.* The Applicant has demonstrated within the application how to make pyrrolopyrimidine and pyrrolotriazine compounds.

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However, there is no working example of any compounds with R or Ar groups other than previously mentioned nor has applicant demonstrated any isomers or racemic or non-racemic mixtures of isomers or hydrates. These cannot be simply willed into existence. As was stated in *Morton International Inc. v. Cardinal Chemical Co.*, 28 USPQ2d 1190 “The specification purports to teach, with over fifty examples, the preparation of the claimed compounds with the required connectivity. However...there is no evidence that such compounds exist...the examples of the '881 patent do not produce the postulated compounds...there is...no evidence that such compounds even exist.” The same circumstance appears to be true here. There is no evidence that any isomers or racemic or non-racemic mixtures of isomers or hydrates of these compounds actually exist; if they did, they would have formed. Hence, applicants must show they can be made, or limit the claims accordingly.

2) *Unpredictability in the art.* It is well established that “the scope of enablement varies inversely with the degree of unpredictability of the factors involved” and physiological activity is generally considered to be an unpredictable factor. (USPQ 18, 24 (CCPA 1970). See *In re Fisher*, 427 F.2d 833, 839, 166.

Chemistry is unpredictable. See *In Re Marzocchi and Horton* 169 USPQ at 367 paragraph 3:

“Most non-chemists would probably be horrified if they were to learn how many attempted syntheses fail, and how inefficient research chemists are. The ratio of successful to unsuccessful chemical experiments in a normal research laboratory is far below unity, and synthetic research chemists, in the same way as most scientists, spend most of their time working out what went wrong, and why. Despite the many pitfalls lurking in organic synthesis, most organic chemistry textbooks and research articles do give the impression that organic reactions just proceed smoothly and that the

total synthesis of complex natural products, for instance, is maybe a labor-intensive but otherwise undemanding task. In fact, most syntheses of structurally complex natural products are the result of several years of hard work by a team of chemists, with almost every step requiring careful optimization. The final synthesis usually looks quite different from that originally planned, because of unexpected difficulties encountered in the initially chosen synthetic sequence. Only the seasoned practitioner who has experienced for himself the many failures and frustrations which the development (sometimes even the repetition) of a synthesis usually implies will be able to appraise such work .....Chemists tend not to publish negative results, because these are, as opposed to positive results, never definite (and far too copious).” Dorwald F. A. *Side Reactions in Organic Synthesis*, 2005, Wiley: VCH, Weinheim pg. IX of Preface.

The scope of “solvate” and “hydrate” is not adequately enabled or defined.

Applicants provide no guidance as how the compounds are made more active *in vivo*. Hydrates cannot be predicted and therefore are not capable of being claimed if the applicant cannot properly enable a particular solvate.

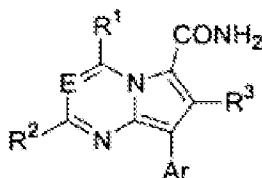
“Predicting the formation of solvates or hydrates of a compound and the number of molecules of water or solvent incorporated into the crystal lattice of a compound is complex and difficult. Each solid compound responds uniquely to the possible formation of solvates or hydrates and hence generalizations cannot be made for a series of related compounds. Certain molecular shapes and features favor the formation of crystals without solvent; these compounds tend to be stabilized by efficient packing of molecules in the crystal lattice, whereas other crystal forms are more stable in the presence of water and/or solvents. There may be too many possibilities so that no computer programs are currently available for predicting the crystal structures of hydrates and solvates. Vippagunta et. al. *Advanced Drug Delivery Reviews* 48 (2001) 3-26.

“Non-racemic mixtures of isomers” literally would include thousands of additional compounds covered by the claims' scope that has the same molecular formula. In the absence of any guidance in the specification, nothing short of extensive synthesis and testing would be needed to determine if any such “isomeric” compound would have the activity needed to practice the invention.

3) *Number of working examples.* The compound core depicted with specific substituents represents a narrow subgenus for which applicant has provided sufficient guidance to make and use; however, this disclosure is not sufficient to allow extrapolation of the limited examples to enable the scope of the compounds instantly claimed. Applicant has provided no working examples of any compounds, compositions or pharmaceutically acceptable salts where the R or Ar variables were not those mentioned above in the present application.

Within the specification, “specific operative embodiments or examples of the invention must be set forth. Examples and description should be of sufficient scope as to justify the scope of the claims. *Markush* claims must be provided with support in the disclosure for each member of the *Markush* group. Where the constitution and formula of a chemical compound is stated only as a probability or speculation, the disclosure is not sufficient to support claims identifying the compound by such composition or formula.” See MPEP 608.01(p).

4) *Scope of the claims.* The scope of the claims involves all of the thousands of compounds of the following formula:



thus, the scope of claims is very broad.

5) *Nature of the invention.* The nature of this invention relates generally to a therapeutic agent for diseases in which corticotropin releasing factor (CRF) is

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considered to be involved, such as depression, anxiety, Alzheimer's disease, Parkinson's disease, Huntington's chorea, eating disorder, hypertension, gastral diseases, drug dependence, cerebral infarction, cerebral ischemia, cerebral edema, cephalic external wound, inflammation, immunity-related diseases, alpecia, irritable bowel syndrome, sleep disorders, epilepsy, dermatitides, schizophrenia, pain, etc. .

6) *Level of skill in the art.* The artisan using Applicants invention would be a chemist with a Ph.D. degree, and having several years of bench experience.

MPEP §2164.01 (a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)." That conclusion is clearly justified here that Applicant is not enabled for making these compounds or compositions or treating the diseases mentioned.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-7 contain the term "pyrrolopyrimidine derivative" or "pyrrolotriazine derivative". These terms are confusing as the term "derivative" is not properly defined

within the specification. Examiner recommends replacing the terms “pyrrolopyrimidine derivative” or “pyrrolotriazine derivative” with the term “compound” to avoid any confusion about what constitutes a derivative. No new matter permitted. Appropriate correction is required.

***Conclusion***

Claims 1-7 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey H. Murray whose telephone number is 571-272-9023. The examiner can normally be reached on Mon.-Thurs. 7:30-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisors, James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey H Murray/

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Patent Examiner , Art Unit 1624